

REMARKS

Claims 1-6, and 11-15 are currently pending. Favorable reconsideration is respectfully requested in view of the remarks presented herein below.

In paragraph 4 of the Office action (“Action”), the Examiner rejects claims 1-3, 11, and 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0046247 A1 to Iwase et al. (“Iwase”) in view of U.S. Patent No. 6,877,031 to Watanabe et al. (“Watanabe”). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-3, 11 and 12 are not rendered unpatentable by the combination of Iwase and Watanabe for at least the reason that the combination fails to disclose each and every claimed element. More specifically, the combination fails to disclose or suggest creating a user ID and password and *transmitting* the user ID to the mail address as claimed.

Iwase discloses a server apparatus in which a groupware is operated. The apparatus includes: a memory to store data; an interface configured to transmit data to a mobile terminal; and a controller configured to form data for transmission to the mobile terminal and separately manage the thus formed data for transmission and data among data addressed to the mobile terminal which is not transmitted to the mobile terminal and is stored in the memory when the

data addressed to the mobile terminal is transmitted to the mobile terminal via the interface (See ¶ [0013] of Iwase). Iwase further discloses that a user ID and password are stored in association with an account name and the mail address of a mobile terminal. However, nowhere in Iwase is there any disclosure or suggestion to transmitting the user ID (as recited in claims 11 and 12) or user ID and password (as recited in claim 1) to the mail address from which the electronic mail with attachment was received.

Watanabe discloses a network photograph service system. The system manages various kinds of information regarding users by the users IDs and passwords stored in the system. In addition, the system provides means for electronic mail transmissions to different users. (See ¶¶ column 7, lines 17-55 of Watanabe). However, nowhere in Watanabe is there any disclosure or suggestion of *transmitting* the user ID or password to the mail address from which an electronic mail with attachment was received as claimed. Accordingly, Watanabe fails to overcome the deficiencies of Iwase.

Since Iwase and Watanabe both fail to disclose or suggest a print service system that includes transmitting the user ID (as recited in claims 11 and 12) or user ID and password (as recited in claim 1) to the mail address from which the electronic mail with attachment was received as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Iwase and Watanabe, the combination would still fail to render claims 1-3, 11, and 12 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and

withdrawal of the rejection of claims 1-3, 11, and 12 under 35 U.S.C. § 103 is respectfully requested.

In paragraph 6 of the Action, the Examiner rejects claims 4-6 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Iwase in view of Watanabe, further in view of U.S. Patent Application Publication No. 2002/0078159 to Petrogiannis et al. (“Petrogiannis”). Applicants respectfully traverse this rejection.

Claims 4-6 variously depend from independent claim 1. Therefore, claims 4-6 are patentable over the combination of Iwase and Watanabe for at least those reasons presented above with respect to claim 1. Petrogiannis discloses a method and system for enabling a correspondent to securely and electronically sign a document. The system of Petrogiannis includes means for generating a user ID and password and transmitting the user ID and password to a third party in an email. However, nowhere in Petrogiannis is there any disclosure or suggestion of transmitting the user ID and password to the mail address from which the electronic mail with attachment was received as claimed. Therefore, Petrogiannis fails to overcome the deficiencies of Iwase and Watanabe.

Since Iwase, Watanabe, and Petrogiannis, each fail to disclose or suggest a print service system that includes transmitting the user ID and password to the mail address from which the electronic mail with attachment was received as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Iwase, Watanabe, and Petrogiannis, the combination would still

fail to render claims 4-6 unpatentable because the combination fails to disclose each and every claimed element.

Independent claim 13, and claims 14 and 15 which depend therefrom, define a print service program that includes, *inter alia*, a user ID creation step for creating a user ID and a password for a mail address used by the user and the mail address of a third party when a mail address of the third party is included in the body of the received electronic mail and a user ID transmission step for transmitting the user ID and the password to the mail address of the user and the mail address of the third party. Therefore, claims 13-15 are patentable over the combination of Iwase, Watanabe, and Petrogiannis for at least reasons similar to those presented above regarding claim 4.

For at least those reasons presented above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 4-6 and 13-15 under 35 U.S.C. § 103(a).

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle Reg. No. 46,607 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/611,962
Amendment dated February 17, 2009
Reply to Office Action of November 17, 2008

Docket No.: 0054-0277P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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